

Application No.: 09/825,357

### REMARKS

Claims 1-9 stand rejected under 35 U.S.C. § 102 as being anticipated by Ochi et al. ("Ochi"). Claim 1 is independent. This rejection is respectfully traversed for the following reasons. As a preliminary matter, it is respectfully submitted that the Examiner has again not specified exactly which elements of Ochi et al. are being read on each of the claimed limitations, and it is respectfully requested that the Examiner do so if the pending rejection is maintained.

The Examiner maintains the pending rejection by asserting that "the recording method identification signal from terminal 10 is the display control signal." From this assertion, as best understood, it appears that the Examiner is interpreting the recording/reproducing unit 3 of Ochi as the claimed "display control unit for outputting a *display control signal* according to the output signal" (emphasis added) because the alleged display control signal of Ochi is outputted from the recording/reproducing unit 3. However, if the Examiner makes this interpretation, then Ochi does not disclose or suggest a corresponding "determining unit" as also recited in claim 1. Ochi simply does not disclose or suggest the *combination* of a "determining unit for ... outputting an output signal to show the result of judging ... [and] a display control unit for outputting a display control signal *according to the output signal*" (emphasis added).

In order to expedite prosecution, the feature of claim 9 has been incorporated into claim 1. Accordingly, claim 1 further recites in pertinent part, "a display unit for displaying the result of judging ... in the determining unit according to the display control signal." The Examiner appears to assert that the TV monitor 11 of Ochi reads on the claimed display unit. However, as mentioned in Applicants' previous response, TV monitor 11 merely displays *the video/audio signal*, not the *result of judging in the determining unit*. Indeed, as mentioned above, Ochi does not disclose the particular "judging" set forth in claim 1, but rather, the recording method

**Application No.: 09/825,357**

identification signal from output terminal 10 simply distinguishes between an analog recording method and a digital recording method to output the selected video/audio signal. Whereas, the present invention can make it possible to display *the judging result* (as opposed to just the conventional display of a video/audio signal as in Ochi), so that the user can know as to when data can be viewed while the user is viewing a broadcast.

As anticipation under 35 U.S.C. § 102 requires that each and every element of the claim be disclosed, either expressly or inherently (noting that "inherency may not be established by probabilities or possibilities", *Scaltech Inc. v. Retec/Tetra*, 178 F.3d 1378 (Fed. Cir. 1999)), in a single prior art reference, *Akzo N.V. v. U.S. Int'l Trade Commission*, 808 F.2d 1471 (Fed. Cir. 1986), based on the forgoing, it is submitted that Ochi et al. does not anticipate claim 1, nor any claim dependent thereon.

Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, *Hartness International Inc. v. Simplimatic Engineering Co.*, 819 F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as claim 1 is patentable for the reasons set forth above, it is respectfully submitted that all claims dependent thereon are also patentable. In addition, it is respectfully submitted that the dependent claims are patentable based on their own merits by adding novel and non-obvious features to the combination.

Based on the foregoing, it is respectfully submitted that all pending claims are patentable over the cited prior art. Accordingly, it is respectfully requested that the rejection under 35 U.S.C. § 102 be withdrawn.

**Application No.: 09/825,357**

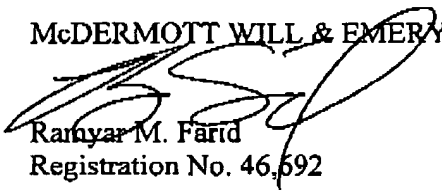
**CONCLUSION**

Having fully responded to all matters raised in the Office Action, Applicants submit that all claims are in condition for allowance, an indication for which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP

  
Ramyar M. Farid  
Registration No. 46,692

600 13<sup>th</sup> Street, N.W.  
Washington, DC 20005-3096  
Phone: 202.756.8000 RMF:men  
Facsimile: 202.756.8087  
Date: May 1, 2006

**Please recognize our Customer No. 20277  
as our correspondence address.**